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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/517,016	08/18/95	MARSHALL	W 31017-011

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EDMUND J. SEASE  
ZARLEY MCKEE THOMTE VOORHEES & SEASE  
801 GRAND AVENUE, SUITE 3200  
DES MOINES IA 50309-2721

EXAMINER	
LARSON, K	
ART UNIT	PAPER NUMBER
1808	

DATE MAILED: 11/27/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents



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APPLICATION NUMBER	FILING DATE 95	MARKS	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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MARGARET M DUNCAN  
MCDERMOTT WILL & EMERY  
227 WEST MONROE STREET  
CHICAGO IL 60606-5096

EXAMINER
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ART UNIT	PAPER NUMBER
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08/23/96

DATE MAILED:

06/13/96

This is in response to the Power of Attorney filed

June 13, 1996

- ☐ 1. The Power of Attorney to you in this application **has been revoked** by the applicant. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.
- ☒ 2. The Power of Attorney to you in this application **has been revoked** by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record. (37 CFR 1.33).
- ☐ 3. The withdrawal as attorney in this application **has been accepted**. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

Jerry G. Dey  
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Patent and Trademark Office

- ☒ 4. The Power of Attorney in this application **is accepted**. Correspondence in this application will be mailed to the below-noted address as provided by 37 CFR 1.33.
- ☐ 5. The Power of Attorney in this application **is not accepted** for the reason(s) checked below:
- ☐ a. The Power of Attorney is from an assignee and the Certificate required by 37 CFR 3.73 (b) has not been received.
- ☐ b. The person signing for the assignee has omitted their empowerment to sign on behalf of the assignee.
- ☐ c. The inventor(s) is without authority to appoint attorneys since the assignee has intervened as provided by 37 CFR 3.71.
- ☐ d. The signature of \_\_\_\_\_, a co-inventor in this application, has been omitted. The Power of Attorney will be entered upon receipt of confirmation signed by said co-inventor.
- ☐ e. The person(s) appointed in the Power of Attorney is not registered to practice before the U.S. Patent & Trademark Office.
- ☐ f. The revocation is not signed by the applicant, the assignee of the entire interest, or one particular principal attorney having the authority to revoke.

EDMUND J. SEASE  
ZARLEY MCKEE THOMTE VOORHEES & SEASE  
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DES MOINES IA 50309-2721

Jerry G. Dey  
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# Office Action Summary

Application No.  
**08/517,016**

Applicant(s)  
**William E. Marshall et al.**

Examiner  
**Kristin K. Larson**

Group Art Unit  
**1808**



☒ Responsive to communication(s) filed on Jun 13, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire            month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s)            is/are withdrawn from consideration.

☐ Claim(s)            is/are allowed.

☐ Claim(s)            is/are rejected.

☐ Claim(s)            is/are objected to.

☒ Claims 1-22 are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on            is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on            is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number)           .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received:           

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).           

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1808

### **DETAILED ACTION**

Claims 1-22 are presented for examination.

#### **Election/Restriction**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to a method of making stress response factors (SRFs) and a composition containing SRFs, classified in class 435, subclass 170, for example.
  - II. Claims 15-21, drawn to a method for modulating the immune system of an animal, classified in class 424, subclass 282.1, for example.
  - III. Claim 22, drawn to a method for desensitizing a human against LPS-induced shock, classified in classes 424 and 514, subclasses 234.1 and 921, respectively, for example.

The inventions are distinct, each from the other because of the following reasons:

inventions I and II and I and III are related as product/process of making the product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product claimed, i.e., the SRF-containing composition, can be used in a materially different process as indicated by the fact that applicant claims two independent and distinct methods of using the composition .

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2. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case, the two methods have different functions and effects since the method of Group II modulates the immune system by activating macrophages whereas the method of Group III desensitizes humans against LPS-induced shock.

The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by the different classification). The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Heidi Neble on November 6, 1996 to request an oral election to the above restriction requirement, but did not result in an election being made. Please note that the restriction above is slightly different than the restriction discussed with Ms. Neble.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

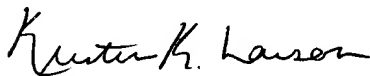
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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

#### **Conclusion**

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristin Larson, whose telephone number is 703-305-7811. The fax number for Art Unit 1808 is 703-305-7401. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1800 receptionist whose telephone number is 703-308-0196.



Kristin K. Larson  
Patent Examiner  
Group 1800  
November 20, 1996